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In re Application of
AARONS, David John, et al.
U.S. Application No.: 09/423,484
PCT No.: PCT/GB98/01155
International Filing Date: 07 May 1998
Priority Date: 07 May 1997
Attorney's Docket No.: P9153
For: GAS DISCHARGE LAMP DRIVE
CIRCUITRY

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' submission of a declaration executed by co-inventor David John AARONS but not by co-inventor John MULLENGER (applicants' claim that Mr. Mullenger has refused to sign the application papers). This submission is being treated as a petition under 37 CFR 1.47(a) for acceptance of the application without the signature of Mr. Mullenger. Applicants have paid the required petition fee.

BACKGROUND

On 07 May 1998, applicants filed international application PCT/GB98/01155 which claimed a priority date of 07 May 1997 and which designated the United States. On 12 November 1998, a copy of the international application was forwarded to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 30 November 1998, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the IB) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 08 November 1999 (07 November 1999 was a Sunday).

On 08 November 1999, applicants filed a transmittal letter for entry into the national stage in the United States which indicates that it was accompanied by: (1) a copy of the international application; (2) an unexecuted declaration, and (3) a check in the amount of \$970 for the basic national fee.

On 08 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The Notification also informed applicant that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 14 April 2000, applicants filed a "Submission Of Late Declaration And Surcharge" which indicates that it was accompanied by: (1) a petition for a one month extension of time to respond; (2) a check in the amount of \$55 in payment of the small entity extension fee; (3) a declaration executed by one of the two inventors; (4) a check in the amount of \$65 as the small entity surcharge for filing the declaration after the 30 month deadline; (5) a Statement Of Facts regarding the failure of the second inventor to sign the declaration; (6) a check in the amount of \$130 as the petition fee; and (7) a small entity statement executed by one of the two inventors.

The materials submitted on 14 April 2000 are considered herein as a petition under 37 CFR 1.47(a). Based on the petition for a one month extension of time, the accompanying fee, and the certification that this submission was mailed on 10 April 2000, the 14 April 2000 filing is considered a timely response to the Notification Of Missing Requirements.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i); (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventor on behalf of himself and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed below, applicants here have satisfied items (1) and (2), but have failed to satisfy items (3) and (4).

Regarding the petition fee, applicants have submitted a check for \$130 as the appropriate petition fee. Item (1) is therefore satisfied. Also, the "Added Page To Combined Declaration And Power Of Attorney For Signature By Joint Inventor(s) On Behalf Of Nonsigning Inventor(s) Who Refuse(s) To Sign Or Cannot Be Reached (37 CFR 1.47(a))" sets forth the last known address for the nonsigning inventor, Mr. Mullenger. Accordingly, item (2) is satisfied.

Regarding item (3), section 409.03(a), of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have submitted a declaration executed by co-inventor David John Aarons and containing an unsigned signature block for the nonsigning inventor, John Mullenger. Pursuant to the MPEP, this declaration can be treated as having been signed by Mr. Aarons on his own behalf and on behalf of Mr. Mullenger. However, there is still a problem with the declaration submitted. The declaration identifies two separate applications as the specification to which it applies, the international application (PCT/GB98/01155) and the priority application (GB 9709075.7). It is therefore unclear which particular specification this declaration executes. Accordingly, the declaration does not satisfy the requirements of 37 CFR 1.497(a) and (b). Item (3) above is therefore not satisfied.

As for item (4), the factual proof required to demonstrate a refusal to execute the application documents is set forth in section 409.03(d) of the MPEP, which states, in part (emphasis added):

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or the declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or the declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Based on the MPEP, a refusal cannot be alleged until after a copy of the **full** application has been forwarded to the nonsigning inventor. Evidence of this mailing must be provided by a person with firsthand knowledge. Here, in the Statement Of Facts executed by David Aarons and submitted in support of the petition, applicants have not provided sufficient, firsthand

evidence that "a copy of the application papers (specification, including claims, drawings, and oath or declaration)" was mailed to the nonsigning inventor for his signature. It appears that the only documents sent to the nonsigning inventor were the declaration and small entity statement (see Statement Of Facts, paragraph 7 and exhibits 3-5). Moreover, these documents were mailed by Leslie Aarons, not David Aarons. Thus, the Statement does not provide firsthand information regarding the mailing of these documents. In addition, the express refusal referred to in the Statement Of Facts involve a conversation between the nonsigning inventor and Mr. Aaron's Patent Attorney, Mr. McLean, and correspondence sent by the nonsigning inventor to Mr. McLean and Leslie Aarons (see Statement Of Facts, paragraphs 9-11 and Exhibits 7-9). As with the mailing of the application documents discussed above, David Aarons is not the proper person to be providing a statement with regard to these facts. Rather, firsthand statements from Mr. McLean and Leslie Aarons are required.

Based on the above, applicants have failed to satisfy items (3) and (4) of the requirements for a grantable petition under 37 CFR 1.47(a). Accordingly, the petition cannot be granted in its present form.

It is noted that, because the application is not presently acceptable without the signature of Mr. Mullenger, the small entity statement submitted by applicants also cannot be accepted without the signature of all the applicants. Thus, applicants are required to pay full fees. Pursuant to the authorizations contained in the 08 November 1999 transmittal letter and the present petition for an extension of time, Deposit Account No. 08-1254 has been charged an additional \$65 as the surcharge for filing the declaration after the 30 month deadline, and an additional \$55 for the extension fee. These charges raise applicants' total payments for these fees to the required amounts.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file a proper response to this decision will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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